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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,465

01/05/2006

Giuseppe Giannini

4865-80

1374

23117

7590

02/18/2009

NIXON & VANDERHYE, PC  
901 NORTH GLEBE ROAD, 11TH FLOOR  
ARLINGTON, VA 22203

EXAMINER

HAVLIN, ROBERT H

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

02/18/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/563,465	<b>Applicant(s)</b> GIANNINI ET AL.	
	<b>Examiner</b> ROBERT HAVLIN	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-17 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 and 12-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 11 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

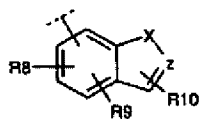
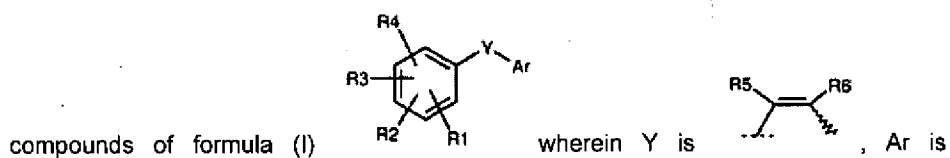
**Status of the claims:** Claims 1, 2, and 5-17 are currently pending.

**Priority:** This application is a 371 of PCT/IT04/00373 (7/6/2004).

### *Election/Restrictions*

The election is as recited in the previous office action:

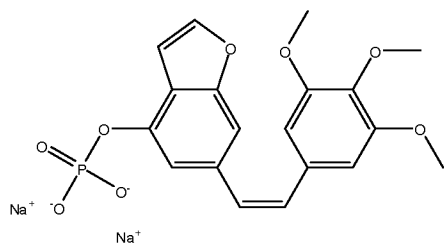
Applicants' election of Group (III), claims 1, 2 and 11, with traverse directed to



X is O, Z is CH, and the rest of the variables are as defined in a

paper filed 06/25/2007 is acknowledged.

Applicant also elected the following species:



disodium 6[(z)-2-(3,4,5-trimethoxyphenyl)ethenyl]-1-benzofuran-4-ol 4-o-phosphate

Because the generic claim encompassing the elected species was not found patentable (as detailed below), the claims are restricted to the elected species ONLY and the remaining subject matter held withdrawn. Claims 1, 2 and 11 are under consideration.

### *Response to Applicant's Arguments*

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1. Claims 1 and 11 were rejected under 35 U.S.C. 102(b) as being anticipated by US 3697513.

Applicant argues the examiner is misinterpreting the claim scope. The issue of the R10 attachment was specifically addressed in a prior office action, however applicant has re-amended the attachment of R10 thereby allowing the interpretation of R10 at multiple sites. Therefore, **this rejection is maintained.**

103 Rejection

2. Claims 1 and 11 were rejected under 35 103(a) as being unpatentable over US 5,858,995 ("Kawai").

Applicant argues that Kawai's disclosure of only one relevant compound out of 295 specific compounds cannot render the instant claims obvious. Applicant also argues "the field of biological activity that the present application deals with, is completely different from the one disclosed by Kawai."

The disclosure of a specific compound as useful for the treatment of bone cancer is sufficient to render the claims obvious because it would motivate one of ordinary skill in the art to apply the well-known principles of structural similarity and bioisostereism to arrive at the instant invention.

Regarding the field of biological activity, Kawai teaches on column 1, line 23-24 that the compounds of the invention are useful for the treatment of bone metastases while page 12 of instant specification states that the invention is useful for treating bone cancer. Therefore the prior art is clearly within the same field of biological activity and the applicant's argument is not persuasive. Applicant also asserts that Kawai seeks to

solve a different technical problem than the instant invention and would treat a different set of patients. This argument is not persuasive because as described above, the patients would substantially overlap because both are useful for treating bone cancer.

For the aforementioned reasons, **this rejection is maintained.**

### ***Objections***

Claim 2 remains objected to for reading on non-elected subject matter resulting from the restriction to the elected species only.

### ***Conclusion***

The claims are not in condition for allowance. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HAVLIN whose telephone number is

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(571)272-9066. The examiner can normally be reached on Mon. - Fri., 7:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Joe McKane can be reached at (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Havlin/  
Examiner Art Unit 1626

/Rebecca L Anderson/  
Primary Examiner, Art Unit 1626